

Atty Docket No. 020618-000600US

PTO FAX NO.: 703.872.9306

ATTENTION: Examiner Q. Janice Li
TELEPHONE NO.: 703.308.7942

Group Art Unit 1632

FAX RECEIVED

OFFICIAL COMMUNICATION

JUL 17 2003

FOR THE PERSONAL ATTENTION OF GROUP 1600

EXAMINER Q. Janice Li

CERTIFICATION OF FACSIMILE TRANSMISSION

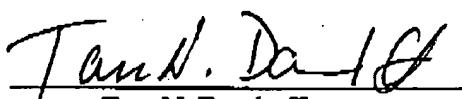
I hereby certify that the following document(s) in re Application of Gregory S. Hageman, Application No. 09/511,008, filed February 22, 2000 for DIAGNOSTICS AND THERAPEUTICS FOR ARTERIAL WALL DISRUPTIVE DISORDERS is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Transmittal Form
2. Fee Transmittal
3. Response To Restriction Requirement (4 pages)
4. Petition for One-Month Extension of Time Under 37 CFR 1.136(a)

Number of pages being transmitted, including this page: 8

Dated: July 16, 2003


Tara N. Damhoff

**PLEASE CONFIRM RECEIPT OF THIS PAPER BY
RETURN FACSIMILE AT (303) 571-4321**

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834
Telephone: 303-571-4000
Fax: 303-571-4321
DE 7110434 v1

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. 703-872-9306 on July 16, 2003.

PATENT
Attorney Docket No.: 020618-000600US
Client Ref. No.: N9-59

TOWNSEND and TOWNSEND and CREW LLP
By: Tara N. Damhoff

#22
Plunkett
7/24/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Gregory S. Hageman

Application No.: 09/511,008

Filed: February 22, 2000

For: DIAGNOSTICS AND
THERAPEUTICS FOR ARTERIAL
WALL DISRUPTIVE DISORDERS

Examiner: Q. Janice Li

Technology Center/Art Unit: 1632

**RESPONSE TO RESTRICTION
REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the Restriction Requirement mailed May 20, 2003. The original deadline for response was June 20, 2003. A petition for a one month extension of time is enclosed, thus extending the period for response until July 20, 2003. Accordingly, this response is timely filed.

In response to the Restriction Requirement, Applicants elect with traverse to prosecute the claims of Group III, which includes claims 1-6 and 69 (in part) and claims 73-75 and 79. The election is made with traverse because it is submitted that the claims in Groups I-IV should be examined together. There are at least two reasons for this.

First, the Office is restricting a single claim (e.g., each of claims 1-6) into multiple inventions which is directly contrary to controlling law. As the C.C.P.A. has stated:

Appl. No. 09/511,008
Amdt. dated July 16, 2003
Reply to Office Action of May 20, 2003

PATENT

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

See, In Re Weber, Soder and Boksay 198 USPQ 328, 331 (C.C.P.A. 1978) (emphasis added).

See also, In Re Haas 179 USPQ 623, 624, 625 (*In Re Haas I*) (C.C.P.A. 1973) and *In Re Haas* 198 USPQ 334-337 (*In Re Haas II*) (C.C.P.A. 1978).

The Office nonetheless takes the position that restriction of a single claim is warranted because it includes distinct inventions. The courts, however, have been clear that the Office cannot restrict a single claim on this basis. The courts have specifically ruled that the statute authorizing restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. *See, In Re Weber, Soder and Boksay, In Re Haas I and In Re Haas II, supra.* As noted in *In Re Weber, Soder and Boksay*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- no matter how broad, which means no matter how many independently patentable inventions may fall within it.

See, In Re Weber, Soder and Boksay at 334.

Instead of imposing a restriction requirement on a single claim, the Office may limit initial examination to a reasonable number of species encompassed by the claim. *See, 37 C.F.R. § 1.146.* This practice strikes an appropriate balance between the concerns of the Office regarding administrative concerns and unduly burdensome examination, and the clear

Appl. No. 09/511,008
Amdt. dated July 16, 2003
Reply to Office Action of May 20, 2003

PATENT

constitutional and statutory rights of an inventor to claim an invention as it is contemplated, provided the dictates of 35 U.S.C. § 112 are complied with. *See*, the MPEP at 803.02. *See also*, *In Re Wolfrum* 179 USPQ 620 (C.C.P.A. 1973) and *In re Kuehl* 177 U.S.P.Q. 250 (C.C.P.A. 1973). Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution, nor does it force an applicant to file multiple divisional applications which are incapable of capturing the intended scope of the application.

Thus, to be consistent with the foregoing case law and rules, if any type of election is to be imposed in this application, Applicants submit that it properly should be a species election requirement rather than a restriction requirement. In this respect it is noted that the Office, in addition to restricting individual claims into multiple groups, is also imposing a species election requirement for each of Groups I-III. It is submitted that the Office should at most simply make a species election requirement with respect to all the claims within Groups I-IV.

If the Office is inclined to maintain the restriction requirement with respect to the claims in Groups I-IV, Applicants request that the Office clearly specify why it deems the foregoing case law not to be controlling with respect to this application.

The second reason the restriction of the claims into Groups I-V is traversed is because claims cannot be restricted without a showing by the Office that a search and examination of the claims on the merits would constitute an undue burden, even when the claims are directed to independent and distinct inventions (MPEP 803.01). In establishing that an "undue burden" exists, the Office must demonstrate that examination of the claims would involve substantially different prior art searches that renders co-examination unduly burdensome. To do this the Office must demonstrate that the restricted groups have a separate classification, have acquired a separate status in the art, or that searching would require a search of different fields (MPEP 808.02).

The Office justifies restriction of the claims by contending that the claims in the different groups are distinct and stating that the differences are underscored by their divergent

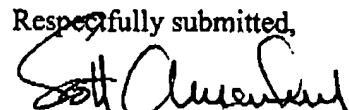
Appl. No. 09/511,008
Amdt. dated July 16, 2003
Reply to Office Action of May 20, 2003

PATENT

classification. In response, it is noted that all the claims in Groups I-IV are not classified to divergent classes; rather, the claims in these groups are not only classified to the same class, but also to the same subclass. The fact that all the claims in these groups have been identically classified demonstrates that a search of the claims in one of these five groups will be coextensive with the search of the claims in the other groups. As such, a search of the claims in one group would not unduly burden the Office.

If, as here, Group III is elected, the Office is also requiring a species election. In response, Applicants provisionally elect CD1a. Claims 1, 2-6, 68-69 and 73 read on this species. In making this species election requirement, it is Applicants' understanding that the Office will follow the procedure set forth in MPEP §809.02(c), which provides for a complete action on the merits of all claims readable on the elected species, and in MPEP §803.02, whereby upon the finding of allowable species, examination will continue with the non-elected species until all species have been examined or a non-allowable species is found.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Scott L. Ausenhus
Reg. No. 42,271

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
SLA:tnd
DE 7106392 v1